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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

CHEUNG, MARY DA ZHI WANG

ART UNIT	PAPER NUMBER
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3621

DATE MAILED: 09/10/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/752,348

Applicant(s)

MAJOR ET AL.

Examiner

Mary Cheung

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 June 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-38 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-38 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Status of the Claims

1. Claims 1-38 are pending. Claims 1, 3, 13, 22, 26 and 33 have been amended.

Response to Arguments

2. Applicant's arguments with respect to claims 1-38 have been considered but are moot in view of the new ground(s) of rejection.
3. Applicant's arguments filed June 18, 2003 have been fully considered but they are not persuasive.

In response to applicant's argument that Peterson (U. S. Paten 5,857,020) fails to teach dynamically decrypting content, Peterson teaches this matter by setting up specific time frame for decrypting and displaying the content (column 6 lines 18-41 and column 7 lines 15-29 and column 8 line 18 – column 9 line 7).

Applicant argues that Hendricks (U. S. Patent 5,798,785) fails to disclose the mater of convoy. In applicant's specification, "convoy" is defined as "the same digital content stream may service multiple consumers" (page 8 lines 29-30). The television delivery system of Hendricks (i.e. Fig. 2) corresponds to this concept.

In regarding to applicant's argument about the screen saver, examiner maintains the rejection.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 33 and 35-38 are rejected under 35 U.S.C. 102(b) as being anticipated by Peterson, Jr., U. S. Patent 5,857,020.

As to claim 33, Peterson teaches a method of use an Internet Box Office (IBO) system for vending copyright-protected multimedia digital content via a computer network to a consumer, the IBO system having a viewing system, a digital rights management system, and a digital content management system, the method comprising (abstract and Fig. 1):

- a) Finding and selecting, through cooperation of the viewing system and the digital content management system, multimedia digital content for playing back (abstract and column 2 line 54 – column 3 line 5 and column 4 line 63 – column 4 line 19 and Fig. 1);
- b) Scheduling a downloaded encrypted multimedia digital content from the digital content management system to the viewing system (abstract and column 5 lines 34-65 and column 6 lines 18-41 and column 7 lines 15-29 and column 8 line 18 – column 9 line 7 and Fig. 1);
- c) Displaying to the consumer, through the cooperation of the viewing station system and the digital rights management system, the copyrighted-protected multimedia digital content as the digital content is dynamically decrypted, and no decrypted version of the digital content is saved on the viewing system (abstract and column 1 lines 12-29 and column 3 line 66 – column 4 line 19 and column 5

lines 44-65 and column 6 lines 18-41 and column 7 lines 15-29 and column 8 line 18 – column 9 line 7 and Fig. 1).

As to claims 35-38, Peterson teaches at least one node for carrying out the method, instruction and data containing for the practice of the method, and electromagnetic signals traveling over a computer network carrying information for the practice of the method (Fig. 1).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

8. Claims 1-13, 17-19, 24 and 26-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Peterson, Jr., U. S. Patent 5,857,020 in view of Downs et al., U. S. Patent 6,574,609.

As to claim 1, Peterson teaches an Internet Box Office (IBO) system adapted to vend multimedia content via a computer network to a consumer, the IBO system comprising (abstract):

- a) A content delivery networking (CDN) infrastructure of the computer network, the CDN infrastructure including deployment enhancements configured to for downloading the multimedia digital content over the network (column 2 lines 54-58);
- b) A viewing system coupled to the deployment enhancements of the CDN infrastructure, the viewing system capable of displaying the multimedia digital content to the consumer (abstract and column 3 line 63 – column 4 line 19 and Fig. 1);
- c) A digital rights management (DRM) system coupled to the viewing system, the DRM system functioning to authorize the multimedia digital content for viewing by the consumer (abstract and column 3 line 66 – column 4 line 19 and Fig. 1);
- d) A digital content management system configured to store the multimedia digital content in encrypted form, the management system interacting with the deployment enhancements of the CDN infrastructure to deliver the encrypted content to the viewing system upon authorization by the DRM system (abstract and column 5 lines 34-65 and Fig. 1), and wherein that dynamically decrypts the encrypted content based on authorization received from the DRM (column 6 lines 18-41 and column 7 lines 15-29 and column 8 line 18 – column 9 line 7).

Peterson does not specifically teach schedule delivery of the encrypted content. However, Downs teaches this matter (column 78 lines 22-40). It would have been obvious to one of ordinary skill in the art at the time the invention was made to allow the teaching of Peterson to include the feature of schedule delivery of the content because this would provide the user with a specific time frame to receive the requested content so that the user can better manage his or her time schedule.

As to claim 2, Peterson teaches a server is coupled to the viewing system to allowing the user to purchase and view a selected digital content (abstract). Peterson does not specifically teach the server organizes titles of the multimedia digital content for browsing by the consumer when selecting the content. However, Downs teaches a server categorizes titles of the multimedia digital content for browsing by the consumer when selecting the content (column 69 line 61 – column 70 line 6). It would have been obvious to one of ordinary skill in the art at the time the invention was made to allow the digital content of Peterson to be organized by titles because it would allow the user to easily find a desired digital content.

As to claim 3, Peterson teaches an Internet Box Office (IBO) system for vending digital content via a computer network to a consumer, the IBO system comprising (abstract):

- a) A viewing system, the viewing system being in electronic communication with the computer network and the viewing system having a user interface (abstract and column 3 line 63 – column 4 line 19 and Fig. 1);

b) A movie management system in electronic communication with the viewing system through the computer network, the movie management system having a play list manager and allowing the user to view a selected digital content

(abstract and column 6 lines 27-41 and Fig. 1);

c) A rights management (DRM) system for granting a right to view a selected digital content, which is encrypted, the right to view being granted by downloading to the viewing system a decryption key enabling decryption of the selected encrypted digital content (abstract and column 1 lines 12-29 and column 3 line 66 – column 4 line 19 and column 5 lines 44-65 and Fig. 1);

d) A display for viewing the selected encrypted digital content downloaded from the movie management system to the viewing system, the selected digital content being dynamically decrypted, through use of the decryption key downloaded from rights management system to the viewing system, so that no decrypted version of the selected encrypted digital content is stored on the viewing system (abstract and column 1 lines 12-29 and column 3 line 66 – column 4 line 19 and column 5 lines 44-65 and column 6 lines 18-41 and column 7 lines 15-29 and column 8 line 18 – column 9 line 7 and Fig. 1).

Peterson does not specifically teach the play list manager having a list of titles of the digital content available for viewing and selected through the user interface.

However, Downs teaches this matter (column 69 line 61 – column 70 line 6). It would have been obvious to one of ordinary skill in the art at the time the invention was made

to allow the play list manager of Peterson to include a list of titles of the digital content because it would allow the user to easily find a desired digital content.

Peterson does not specifically teach the download is scheduled. However, Downs teaches this matter (column 78 lines 22-40). It would have been obvious to one of ordinary skill in the art at the time the invention was made to allow the teaching of Peterson to include the feature of scheduling downloads because this would provide the user with a specific time frame to receive the requested content so that the user can better manage his or her time schedule.

As to claim 4, Peterson further teaches a billing system for accepting payment through the viewing system for the right to view, and the billing system applying a discount to the consumer (abstract and column 3 lines 7-35). Peterson does not specifically teach applying a discount if the consumer has agreed to view digital content in addition to the selected digital content. It would have been obvious to one of ordinary skill in the art to allow the billing system of Peterson to include this commonly used sale strategy (i.e. rent one get the second one half price) for promoting faster sell of the digital contents.

As to claim 5, Peterson teaches the digital content further comprises interactive digital content, movies, ads, and trailers (abstract).

As to claim 6, Peterson teaches the viewing system receives from the movie management system information in advance of a predetermined premier event date (column 7 lines 41-43). Peterson does not specifically teach the viewing system receives from the movie management system and displays to the consumer information

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about the status of the digital content being downloaded. Downs teaches displaying the status of the digital content being downloaded (column 47 line 37 – column 48 line 31). Downs does not specifically teach displaying the status to the consumer. It would have been obvious to one of ordinary skill in the art to allow the status in Downs teaching to be displayed to the consumer because it would allow the consumer to know the status of the desired digital content. Furthermore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to allow the viewing system of Peterson to receive the status of the digital content being downloaded because it would allow the consumer to easily view the status of the desired digital content.

As to claim 7, Peterson teaches the right management system protects the decrypted key during a fixed length of time and ensures that the decryption key expires after the fixed length of time (column 8 lines 52 – column 9 line 20 and Fig. 3).

As to claim 8, Peterson teaches the right management system provides usage tools for controlling interface between the consumer and the digital content, and tracking tools for use and distribution of the digital content (column 3 lines 6-35 and Figs. 1, 3).

As to claim 9, Peterson teaches secured and managed communication through the computer network to protect the rights of an owner of the digital content (abstract and Fig. 1).

As to claim 10, Peterson teaches a policy management process for leasing the digital content, a monitoring process for monitoring adherence to the lease of the digital content, and a purging process for erasing the downloaded digital content when the

lease expires (column 3 lines 6-35 and column 8 line 52 – column 9 line 3 and column 10 lines 4-19 and Figs. 1, 3).

As to claims 11-13, Peterson does not specifically teach the movie management system has a plurality of movie studio web servers, the movie studio web servers are located at a plurality of web sites, and optimally schedule downloading of the selected digital content from the movie studio web servers based on consumer directions. However, Downs teaches these matters (column 9 lines 29-38 and column 78 lines 22-40 and Figs. 1A-1D). It would have been obvious to one of ordinary skill in the art at the time the invention was made to allow the system of Peterson to include these features because it would allow consumer to request various types of digital contents.

As to claim 17, Peterson does not specifically teach a screen saver function. However, screen saver function is well known in the art and it is also commonly used. It would have been obvious to one of ordinary skill in the art to allow the system of Peterson to include this commonly used feature of screen saver so that it provides pleasant view to consumer during downloading.

As to claim 18, Peterson teaches the digital content is copyrighted; a managed storage system for storing the encrypted digital content on the viewing system in encrypted form (abstract and column 5 lines 34-65 and Fig. 1).

As to claim 19, Peterson teaches a feature permitting the consumer to choose a time at which to view the downloaded digital content (column 4 line 20 – column 5 line 3).

As to claim 24, Peterson modified by Downs teaches user interface is a web browser (Peterson: Fig. 1; Downs: Fig. 1D).

Claims 26-32 are rejected for the similar reasons as claims 3-4.

9. Claims 14-16, 20-23, 25 and 34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Peterson, Jr., U. S. Patent 5,857,020 in view of Downs et al., U. S. Patent 6,574,609 in further view of Hendricks et al., U. S. Patent 5,798,785.

As to claims 14-16 and 20, Peterson modified by Downs does not specifically teach using a cache local to viewing system. However, Hendricks teaches these matters (Fig. 2). It would have been obvious to one of ordinary skill in the art at the time the invention was made to allow the system of Peterson modified by Downs to include these features because it would allow consumer to request various types of digital contents and it would also allow the consumer to fast access the requested digital contents.

As to claim 21-22, Peterson modified by Downs further modified by Hendricks as discussed above further teaches transmitting interruption signals (Hendricks: column 2 lines 55-61 and column 25 line 42 – column 27 line 24). Peterson modified by Hendricks does not specifically teach automatically resumes an interrupted download operation, and the downloads are queued so that the computer network substantially maintains its pre-download performance. It would have been obvious to one of ordinary skill in the art to allow the downloading method of Peterson modified by Downs further modified by Hendricks to include automatically resuming an interrupted download operation, and the downloads are queued for maintaining the pre-download

performance because it would allow the users for fast and efficiently downloading digital contents.

As to claim 23, Peterson modified by Downs further modified by Hendricks as discussed above further teaches tracking the consumer's usage history (Peterson: column 11 lines 1-4; Downs: column 12 lines 31-35; Hendricks: column 13 lines 56-58 and column 22 lines 14-21). Peterson modified by Downs further modified by Hendricks does not specifically teach allowing the consumer to specify a maximum number of trailers to download for each movie downloaded. It would have been obvious to one of ordinary skill in the art to allow tracking method of Peterson modified by Downs further modified by Hendricks to include the feature of allowing the consumer to specify a maximum number of trailers to download for each movie downloaded for suiting the best interest of the consumer in terms of obtaining the trailers.

As to claim 25, Peterson modified by Downs further modified by Hendricks as discussed above further teaches providing a accommodate streaming video media (Hendricks: Figs. 2, 11a-11e).

Claim 34 is rejected for the similar reasons by combining claims 6 and 21-22 as discussed above.

Conclusion

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Inquire

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mary Cheung whose telephone number is (703)-305-0084. The examiner can normally be reached on Monday – Thursday from 8:00 AM to 5:30 PM. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell, can be reached on (703) 305-9768.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.

The fax phone number for the organization where this application or proceedings is assigned are as follows:

(703) 872-9306 (Official Communications; including After Final
Communications labeled "BOX AF")
(703) 746-5619 (Draft Communications)

Hand delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive, 7th Floor Receptionist.

Mary Cheung
Patent Examiner
Art Unit 3621
September 5, 2003


JAMES P. TRAMMELL
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